IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF APPEALS AND INTERFERENCES

In re Application of: Cohen et al.

Serial No:	10/713,843	Art Unit:	1617
Filed:	November 15, 2003	Examiner:	San Ming R. Hui
Confirmation No.: 2762		Docket No.:	02.14US

For: TRANSPARENT CONCEALING
COSMETIC COMPOSITIONS

APPELLANT'S BRIEF PURSUANT TO 37 CFR 41.31

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir/Madam,

Appellants hereby appeal to the Board of Patent Appeals and Interferences from the final rejection of claims 1-7 and 10-14 of the above-identified U.S. patent application in the Office Action dated July 22, 2009.

STATEMENT OF REAL PARTY IN INTEREST

The name of the real party in interest in this appeal is Color Access, Inc., the assignee of the application.

RELATED APPEALS AND INTERFERENCES

There are no other appeals, interferences, or judicial proceedings known to Appellants, the Appellants' legal representative, or assignee which may be related to this, directly affect or be directly affected by or have a bearing on the Board's decision in this appeal. No claims were allowed.

STATUS OF THE CLAIMS

Among all pending claims 1-24 in the proceeding, claims 1-7 and 10-14 were finally rejected, and claims 8, 9 and 15-24 have been withdrawn. No claims were allowed. The claims on appeal are claims 1-7 and 10-14, which are presented herewith in the Claims Appendix.

STATUS OF AMENDMENTS

There has been no amendment, affidavit, or other evidence filed after the final rejection of July 22, 2009.

SUMMARY OF CLAIMED SUBJECT MATTER

Independent claim 1 of the present application, from which claims 2-7 and 10-14 depend, recites a composition for topical application to the skin, which comprises: (a) a transparent component having a light transmission value of greater than about 70% and an average particle size of about 1 micron to about 10 microns (see page 3, lines 3, 13-14, and 20-22 of the instant specification as originally filed); and (b) a non-interference platelet component having an average particle size of about 15 microns to about 22 microns, the platelet exhibiting a light

transmission value of about 20% to about 70%, and a light reflectance value of about 10% to about 20% (see page 4, lines 7-9, 13-15, 19-20, and 27-28 of the instant specification as originally filed).

The composition recited by claim 1 is designed specifically for topical application to the skin, and more specifically for concealing flaws on the skin, as described by the instant specification at page 1, lines 3-4 and page 2, lines 12-28. The transparent component (a) recited by independent claim 1 can be a glass bead or microsphere, as further specified by dependent claim 3 and described by the instant specification at page 3, lines 17-18. The non-interference platelet component (b) recited by independent claim 1 can be an alumina flake, or more particularly a titanium dioxide coated alumina flake, as further specified by dependent claims 4 and 5 and described by the instant specification at page 4, lines 24-27.

The topical composition of claim 1 can further contain a supplemental component (c), which is a non-interference platelet component having a light transmission value of less than about 20%, as recited by dependent claim 2 and described by the instant specification at page 5, lines 28-31. Such supplemental component (c) can be a pearlescent platelet having an average particle size of less than 50μ and more preferably bismuth oxychloride, as further specified by dependent claims 6 and 7 and described by the instant specification at page 5, lines 30-33.

The topical composition of claim 1 can further contain an additional supplemental component (d), which is an interference silica flake pigment, as recited by dependent claim 10 of the present application and described by the instant specification at page 6, lines 22-28.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The sole issue to be reviewed by the Board on this Appeal is whether claims 1-7 and 12-14 are unpatentable under 35 U.S.C. 103(a) over U.S. Patent No. 6,242,056 issued in the names of Spencer et al. (hereinafter "the '056 Patent") in view of European Patent Application Publication No. 1013724A1 filed by Merck Patent GmbH (hereinafter "the '724 Application"). Specifically the question is whether it would be obvious for a person ordinarily skilled in the art to combine the teachings of the '056 Patent and the'724 Application to yield the claimed composition for topical application to the skin, as recited by claims 1-7 and 12-14 of the present application.

ARGUMENT

The claimed invention as recited by independent claim 1, from which claims 2-7 and 10-14 depend, is a **"composition for topical application to the skin"** that contains at least two components, i.e., **a transparent component (a)** and **a non-interference platelet component (b)**. The transparent component (a) has a light transmission value of greater than about 70% and an average particle size of about 1 micron to about 10 microns. A preferred example of such transparent component (a) is a glass bead or microsphere, as recited by the dependent claim 3. The non-interference platelet component (b) has an average particle size of about 15 microns to about 22 microns and exhibits a light transmission value of about 20% to about 70% and a light reflectance value of about 10% to about 20%. A preferred example of such non-interference platelet component (b) is an alumina flake, and more preferably a titanium dioxide coated alumina flake, as recited by the dependent claims 4 and 5. Further, the claimed composition of the present application can contain **a supplemental component (c)**, which is a non-interference platelet component having a light transmission value of less than 20%. A preferred example of such supplemental component (c) is bismuth oxychloride.

Rejection under 35 U.S.C. §103(a)

The rejection of claims 1-5 and 10-14 has been maintained by the Examiner. The basis for the rejection is:

> "[The '056 Patent] teaches a paint composition containing glass beads and a colorants such as alumina (See the abstract). '056 also teaches the particle size of glass beads as 10-20 microns (See col. 2, line 28 for example). '056 teaches the glass beads can be clear and have light refractive value of 1.5-2.5 (See col. 3, line 64).
>
> [The '724 Application] teaches a pigment mixtures comprising titanium oxide coated alumina (Al_2O_3) and bismuth oxychloride (BiOCl) (See paragraph [0019]) with improved hiding power (see paragraph [0002]). '724 teaches the composition is useful for paint and cosmetics (See the abstract for example).
>
> The references do not expressly teach the pigments taught in '724 be incorporated into the cosmetic composition of '056. The references do not expressly teach the herein recited particle size of pigments and glass beads

and amount. The references do not expressly teach the glass beads to have a light transmission value of greater than 70%.

It would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the pigments taught in '724 into the composition of '056. It would have been obvious to one of ordinary skill in the art at the time of invention to adjust the amount and particle size of the herein components. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to use the glass materials with light transmission of at least 85% in the cosmetics.

One of ordinarily skill in the art would have been motivated to incorporate the pigments taught in '724 into the composition of '056 since incorporating the pigments taught in '724 into the paint composition of '056 would improve the hiding power and impact the glossy appearance of the colored composition of '056. Furthermore, one of ordinary skill in the art would have been motivated to adjust the particle size and amount of the herein claimed components since optimization of the result parameters is obvious as being within the purview of skilled artisan. The components of '056 are taught to have specific refractive index and therefore, employing the appropriate components with desirable light transmission properties such as the instant claimed would be seen to be obvious as being within the purview of skilled artisan." (July 22, 2009 Final Office Action, pages 3-4)

This rejection is again respectfully traversed.

1. The '056 Patent

The Examiner cited the '056 Patent as the primary reference that teaches the use of transparent glass beads with particle sizes in the range of 10-20 microns and light refractive values in the range of 1.5-2.5.

However, the '056 Patent is directed to **paint compositions or coatings** "for spray-painting automobiles, boats, aircrafts and home appliances" (see Abstract of the '056 Patent), instead of cosmetic or topical compositions for topical application to the skin, as positively recited by claims 1-7 and 10-14 of the present application. Ingredients used in paint compositions or coatings for spray-painting automobiles, boats, aircrafts and home appliances are *very different* from those used in cosmetic or topical compositions. The former are selected to optimize drying speed, weather durability, chip resistance, adhesion, and optical effect on the metal surfaces, while the latter are selected to optimize wearability, spreadability, texture, feel, comfort, and optical effect on the skin. Furthermore, ingredients used in compositions for topical application to the skin have to pass various FDA required safety and toxicity tests, while

ingredients used in spray-paint compositions for automobiles, boats, aircrafts and home appliances do not. In other words, the mere fact that an ingredient has been known for its use in spray-paint coatings for automobiles, boats, aircrafts and home appliances does not deem such an ingredient appropriate for use in cosmetic or topical compositions. Therefore, it is improper for the Examiner to extrapolate the teaching by the '056 Patent of using transparent glass beads in spray-paint compositions for automobiles, boats, aircrafts and home appliances as support for obviousness of using such transparent glass beads in cosmetic or topical compositions, which are to be applied to the skin, without any further evidentiary support.

It has been well established that in order to rely on a prior art reference as a basis for rejection of an applicant's invention, the reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. See *In re Oetiker,* 24 USPQ2d 1443, 1445 (Fed. Cir. 1992); and *In re Deminski*, 230 USPQ 313, 315 (Fed. Cir. 1986). The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself. See *In re Oetiker*, at 1446; and *Diversitech Corp. v. Century Steps, Inc.*, 7 USPQ2d 1315, 1318 (Fed. Cir. 1988).

In the present case, the '056 Patent is directed to formulation of paint compositions or coatings for spray-painting automobiles, boats, aircrafts and home appliances, which is very different from the field of the Appellants' endeavor, namely, formulation of topical compositions for application to the skin. The '056 Patent teaches the use of light-refractive colorless and/or tinted transparent glass beads having an average diameter of about 10-20 microns in the spray-paint compositions or coatings for enhancing the light refraction and color intensity and richness of the paint layers (see the '056 Patent, column 2, lines 20-28). However, nothing in the '056 Patent teaches or suggests in any manner that the transparent glass beads disclosed therein can be used in cosmetic or topical compositions.

More importantly, the '056 Patent teaches that the transparent glass beads are used in the spray-paint compositions or coatings together with a resinous binder material that is cross-linkable upon heating or UV radiation to cure and thereby form a hard, translucent, chip-resistant

paint layer, in which the transparent glass beads are embedded or encapsulated (see the '056 Patent, Abstract and column 2, lines 20-28). The particle sizes of the transparent glass beads are carefully selected to be at least 10% less than the thickness of the cured paint layer, so that the transparent beads are completely encased or encapsulated within the cured paint layer and do not protrude at the surface of the cured paint layer, which will adversely affect the light-refraction and internal color enhancement properties (see the '056 Patent, column 3, lines 48-51; column 5, lines 65-68; and column 6, lines 1-6). It is therefore clear that the combined use of the transparent glass beads and the heat/UV-curable resinous binder material is critical for the invention described by the '056 Patent. Without the heat/UV-curable resinous binder materials to form the hard cured paint layer for completely encasing or encapsulating the transparent glass beads, the light light-refraction and internal color enhancement properties of the invention described by the '056 Patent will be adversely affected, which defeats the purposes of such invention.

Therefore, there is no reason, suggestion or motivation from the '056 Patent that would have prompted a person ordinarily skilled in the art to pick out the transparent glass beads disclosed by the '056 Patent, and only the transparent glass beads, for use in a cosmetic or topical composition without the heat/UV-curable resinous binder material disclosed by the '056 Patent.

In the July 22, 2009 Final Office Action, the Examiner asserted that:

> "Absent evidence showing the pigment composition as toxic or not suitable for topical use, one of skill in the art would have been motivated to employ the pigment composition of the cited prior art for cosmetic use (i.e., applying onto the skin)."

Such assertion by the Examiner attempts to shift the burden of proof to the Appellants and asks the Appellants to prove the impossibility of employing the pigment composition for spray-painting automobiles, boats, aircrafts and home appliances as disclosed by the '056 Patent for cosmetic or topical uses, without establishing a proper *prima facie* case in support of the obviousness of such uses first. However, it has been well established that during patent examination, the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. See *In re Oetiker*, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If the PTO fails to meet this burden, then the applicant is entitled

to the patent. Only when a *prima facie* case is already established by the PTO, the burden of proof shifts to the applicant to come forward with evidence and/or argument supporting patentability. See *In re Glaug*, 62 USPQ2d 1151, 1152 (Fed. Cir. 2002).

Further, the '056 Patent clearly teaches that the paint compositions disclosed therein contain a curable resinous binder system with a cross-linkable polymer and a cross-linking agent, so that upon heating or ultraviolet exposure, such paint compositions or coatings will be cured to form a clear, hard, glasslike paint layer (see the '056 Patent, column 5, lines 8-13), which are obviously NOT suitable for cosmetic use or for topical application to the skin. Therefore, there is clear and convincing evidence in the disclosure of the '056 Patent that the pigment compositions disclosed therein are not suitable for cosmetic use or topical application to the skin.

In the July 22, 2009 Final Office Action, the Examiner further asserted that the '056 Patent teaches the use of "a colorants such as alumina" in the Abstract (see Office Action, page 3, lines 1-2).

Appellants would like to point out here that such assertion by the Examiner is incorrect. The '056 Patent does not teach the use of alumina; instead, it teaches the use of aluminum flakes (see the Abstract of the '056 Patent), which is different from alumina. Alumina is aluminum oxide (Al_2O_3), which is a metal oxide, while aluminum is an un-oxidized elemental metal.

2. The '724 Application

The Examiner cited the '074 Application as the secondary reference that teaches the use of titanium oxide coated alumina (Al_2O_3) and bismuth oxychloride (BiOCl). The '074 Application is directed to pigment mixtures that can be used in various compositions of different applications, including cosmetic formulations.

However, nothing in the '074 Application teaches or suggests the use of transparent glass beads, or any other transparent component having a light transmission value of greater than about 70% and an average particle size of about 1 micron to about 10 microns, as positively recited by the independent claim 1 of the present application.

3. The Combined Teachings of the '056 Patent and the '724 Application

The combined teachings of the primary and secondary references cited by the Examiner, i.e., the '056 Patent and the '724 Application, fail to render the claimed invention of the present application obvious, because they fail to teach the claimed composition for topical application to the skin containing both the transparent component (a) and the non-interference platelet component (b), as positively recited by claims 1-7 and 10-14 of the present application.

First, neither the primary nor the secondary reference teaches or suggests the use of a transparent component meeting all the limitations of the independent claim 1 in a topical composition for application to the skin, as explained hereinabove.

Second, according to the Examiner, the combined teachings of the '056 Patent and the '724 Application, would motivate one ordinarily skilled in the art to "incorporate the pigments taught in '724 into the composition of '056" to "improve the hiding power and impact the glossy appearance of the colored composition of '056" (see the July 22, 2009 Final Office Action, page 3, lines 20-22 and page 4, line 1). However, such hypothetical combination as proposed by the Examiner, i.e., incorporation of the pigments taught in the '724 Application into the composition of the '056 Patent, would result in a paint composition that contains titanium oxide coated alumina (Al_2O_3) and bismuth oxychloride (BiOCl) taught by the '724 Application in addition to the transparent glass beads and the heat/UV-curable resinous binder material taught by the '056 Patent. Upon heating or ultraviolet exposure, such a paint composition will be cured to form a clear, hard, glasslike paint layer as described by the '056 Patent, which is suitable for spray-painting automobiles, boats, aircrafts and home appliances, but NOT suitable for topical application to the skin. Therefore, the hypothetical combination of the '056 Patent and the '724 Application as proposed by the Examiner fails to yield a topical composition suitable for application to the skin, as positively recited by claims 1-7 and 10-14 of the present application.

CONCLUSION

In light of the arguments presented above, the obviousness rejection of claims 1-7 and 10-14 based on the '056 Paten in view of the '724 Application is unfounded. Accordingly, Appellants respectfully request that the Honorable Board reverse the decision of the Examiner in finally rejecting claims 1-7 and 10-14 of the present application and declare that such claims are allowable.

In view of the foregoing remarks, it is firmly believed that the present application is in condition for allowance, which action is again solicited.

Respectfully submitted,

Date: 04/15/2010

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CLAIMS APPENDIX

1. A composition for topical application to the skin comprising (a) a transparent component having a light transmission value of greater than about 70% and an average particle size of about 1 micron to about 10 microns; (b) a non-interference platelet component having an average particle size of about 15 microns to about 22 microns, the platelet exhibiting a light transmission value of about 20% to about 70%, and a light reflectance value of about 10% to about 20%.

2. The composition of claim 1 which further comprises at least one supplemental component (c) which is a non-interference platelet component having a light transmission value of less than about 20%.

3. The composition of claim 1 in which the transparent component is a glass bead or microsphere.

4. The composition of claim 1 in which the platelet (b) is an alumina flake.

5. The composition of claim 1 in which the platelet is a titanium dioxide coated alumina flake.

6. The composition of claim 2 in which the non-interference component (c) is a pearlescent platelet having an average particle size of less than about 50μ.

7. The composition of claim 6 in which the non-interference component is bismuth oxychloride.

10. The composition of claim 2 which comprises an additional supplemental component (d) which is an interference silica flake pigment.

11. The composition of claim 1 comprising (a) a glass bead or microsphere having an average particle size of about 1 micron to about 10 microns; (b) a non-interference platelet having an average particle size of about 15 microns to about 22 microns, the platelet exhibiting a light transmission value of about 20% to about 70%, and a light reflectance value of about 10% to about 20%; and optionally (c) a non-interference pearlescent or metallic platelet having a light transmission value of less than about 20% and (d) an interference silica flake pigment.

12. The composition of claim 1 which comprises at least one metal oxide pigment in an amount of less than about 15%.

13. The composition of claim 12 in which the metal oxide is a nanopigment.

14. The composition of claim 1 which is a whitening product.

EVIDENCE APPENDIX

No evidence is presented.

RELATED PROCEEDINGS APPENDIX

There are no related proceedings or decisions.